



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

2

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.   |
|---|-------------|----------------------|---------------------|--------------------|
| 09/740,263  | 12/18/2000  | Keith Barraclough    | 8X8S.223PA          | 5757               |
| 40581   | 7590        | 08/11/2005           | EXAMINER            |                    |
| <b>CRAWFORD MAUNU PLLC</b><br>1270 NORTHLAND DRIVE, SUITE 390<br>ST. PAUL, MN 55120 |             |                      |                     | SHANNON, MICHAEL R |
| ART UNIT  |             | PAPER NUMBER         |                     |                    |
|   |             | 2614                 |                     |                    |

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

09/740,263

**Applicant(s)**

BARRACLOUGH ET AL.

**Examiner**

Michael R. Shannon

**Art Unit**

2614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.

b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
  - (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  They raise the issue of new matter (see NOTE below);
  - (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13.  Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 12 July 2005 have been fully considered but they are not persuasive.

The Applicant has filed After Final arguments relating to the 102(b) rejection of claims 11, 12, and 13 and the 103(a) rejections, specifically bringing the rejection to claim 20 to the Examiner's attention.

Regarding the arguments presented towards claim 11, the Applicant states, "The Examiner has repeatedly glossed over an important and distinguishable requirement of claim 11 that the 'NIU is adapted to store incoming external services data until a routing command is received from the user input device". In response to this argument, the Examiner makes it clear that he did not intentionally "gloss over" the requirements of claim 11, instead he set forth a general argument, which, upon further reading of the cited prior art, would have been clearly understood as a valid rejection to the claimed "NIU adapted to store incoming external services data until a routing command is received from the user input device". The Examiner originally stated that the claim is met by "the discussion of routing of signals and information to appropriate interface pods 44 and the system database storage 48, which together server to store incoming mass media and route the media, as appropriate to the selected (via user input) device [col. 4, lines 9-26]." The Examiner still maintains this position and provides the following explanation to further clarify his point.

The Applicant points out that since the cited “database storage 48” is not housed in the NIU the claim is not met. However, according to the claim language, the NIU is merely adapted to store incoming external services data, with no mention that the external services data must be stored internally in the NIU. Furthermore, the Applicant explains that “adapted to store,” means that the “NIU is adapted to use memory that is adapted to store external-services data, such as audio and video recordings, email, and voicemail. The memory may, for example, be included in the NIU, or may be an external memory, such as part of an appliance in the user facility or at an external-service provider, such as memory located as a communications terminal” (as disclosed in the original specification, page 13, lines 13-17). Therefore, as is disclosed by the Applicant and is understood and read by the Examiner, “adapted to store” does not mean that the memory must be housed in the NIU, in blatant contrast with that, “adapted to store” covers many scenarios where the external-services may be stored.

Furthermore, regarding claim 11, the Applicant states that “Hamlin does not store incoming external services data and thus fails to correspond to Applicant’s requirement that the ‘NIU is adapted to store incoming external services data until a routing command is received from the user input device’”. In fact, the Hamlin reference does disclose this functionality, taking into account that the data can be stored external to the NIU (as presented above). As an example, which would have been clearly noticeable upon a thorough review of the Hamlin reference, he outlines one scenario wherein the user elects to route a pre-stored “Go to Bed” video signal to a chosen receiving unit 46. The command to route the video signal is received via the remote controller 42 from the

parents to command the system controller to send the video signal to the receiving unit 46 [col. 6, lines 46-65]. Also, to serve as another example, the user can choose which device to records which program and at later a later time, route that recorded program to a chosen television set. According to column 5, lines 46-60, wherein Hamlin discloses "a user can use the remote controller 42 to direct any mass media signal 22 to be distributed to any room". The example goes on to detail a scenario wherein the parents elect to record a program to a VCR via the remote controller 42. Therefore, these examples and the original rejection can be taken to maintain the rejection to claim 11.

Regarding the arguments presented towards claim 12, the Applicant states "Other limitations seemingly ignored by the Examiner include the claim 12 limitation that the user input device be 'adapted to communicate with the NIU and determine the type of data that is stored'". The Examiner contends that this limitation is met by the Hamlin reference. As originally stated, the claim is met by "the system controller's ability to store and maintain format information and allow the user to utilize the information accordingly and route it to the correct device in the network [col. 4, lines 9-33]." To further explain, the remote controller 42 can "direct any mass media signal 22 to be distributed to any room" [col. 5, lines 46-48]. The system database 48, which stores the routing information, also stores the data type and the frequency band that the signal is associated with. Each type of signal is assigned a different frequency; therefore, the user can determine the type and source of the signal based on the frequency that it is placed on the common bus [col. 3, lines 30-48]. Therefore, the Examiner submits that it

is inherent that the routing information and remote controller could be used to determine the type of data that is stored, as previously discussed. Therefore, the original rejection of claim 12 still stands.

Regarding the arguments presented towards claim 13, the Applicant states, "The Examiner further fails to identify where Hamlin teaches 'the user input device is adapted to determine the source of the data'". As originally stated, the Examiner contends that this claim is met by "the system database storage 48, within the system controller 38, which serves to store information on the incoming signal and its frequency and source [col. 4, lines 16-29]. Also, as discussed with reference to claim 12, the system database 48, which stores the routing information, also stores the data type and the frequency band that the signal is associated with. Each type of signal is assigned a different frequency; therefore, the user can determine the type and source of the signal based on the frequency that it is placed on the common bus [col. 3, lines 30-48] through interaction with the remote controller [col. 5, lines 46-48]. Therefore, the Hamlin reference, clearly meets claim 13's limitation.

Regarding the arguments presented towards the lack of motivation to combine the Hamlin and Goldstein reference to form the rejection of claim 20, the Examiner responds by further clarifying the rejection and providing specific examples in the prior art where the combination is suggested. The Hamlin reference does not teach the inclusion of a security code in the input device, wherein the NIU is further adapted to respond only to commands having the security code. However, the Goldstein reference does disclose that a system for operating multiple devices (much like the Hamlin

Art Unit: 2614

reference) in which the cable converter box responds to only commands sent from a remote control with a specific identification number, for security purposes [col. 4, lines 57-65]. The Examiner therefore concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention to use a security code in the remote controller, in order to allow for tighter security and use by only those authorized users. According to the Goldstein reference, the use of the security code would only allow control of devices when the ID number was verified, thus providing a higher level of security to the remote control for controlling multiple devices. The converter 34 of the Hamlin reference functions in much the same way as that of the Goldstein reference. The Hamlin converter serves to control multiple devices throughout the network and to interface multiple input signal lines to the communication bus 36, in other words, it is a centralized set-top box (or cable converter box). The motivation for placing security into the converter 34 is simple, since the Hamlin reference seeks to improve the compatibility between many devices and to expand upon the converter box (a common device in the art) taught by Goldstein, it would have been obvious to one of ordinary skill in the art to include security into the expanded cable box. Therefore, the original rejection, with the motivation being of common knowledge generally available to one of ordinary skill in the art, still stands.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Shannon who can be reached at (571) 272-

Art Unit: 2614

7356 or Michael.Shannon@uspto.gov. The examiner can normally be reached by phone Monday through Friday 8:00 AM – 5:00PM, with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

**Any response to this action should be mailed to:**

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

United States Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

**Or faxed to: (571) 273-8300**

**Hand-delivered responses should be brought to:**

Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (571) 272-2600.

Michael R Shannon  
Examiner  
Art Unit 2614

Michael R Shannon  
July 25, 2005



JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600